



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,338	11/27/2001	Jeffry J. Grainger	020313-000730US	1985

20350 7590 09/25/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/996,338	GRAINGER, JEFFRY J.
Examiner	Art Unit	
Jan Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 3/11/03 and 6/30/03 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 4-9, 11-13, 19 and 20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 4-9, 11-13, 19 and 20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 30 June 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6) Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on June 30, 2003, wherein:

Claims 4-9, 11-13 and 19-20 are currently pending;

Claims 1-3, 10, and 14-18 have been canceled;

Claims 4-9 and 11-13 have been amended; and

Claims 19 and 20 have been added.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on March 11, 2003 is being considered by the examiner.

Drawings

3. The drawings were received on June 30, 2003. These drawings, replacement drawings 1 and 5, are acceptable.

Oath/Declaration

4. The examiner *withdraws* the objection to the oath or declaration. An application data sheet is in fact in the file with the appropriate information.

Claim Rejections - 35 USC § 112

5. The rejection under the second paragraph of 35 U.S.C. 112 as to claims 14, 15, 17, and 18 for being indefinite for containing the phrase "includes" is hereby *withdrawn*.

Response to Arguments

6. Applicant's arguments with respect to claims 4-9, 11-13, and 19 -20 have been considered but are moot in view of the new ground(s) of rejection.

Response to Amendment

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 19 and 4,5,9,11 are rejected under 35 U.S.C. 102(e) as being anticipated by International Business Machines Corporation (WO 02/05150) (hereinafter referred to as IBM).

Referring to Claim 19:

IBM discloses a method of managing documents related to a plurality of patent applications, the method comprising: for a plurality of different and unrelated technology developers, allowing client systems from each such technology developer to create a plurality of invention disclosures for each respective technology developer (Fig. 2 (270), page 22 line 17 thru page 23 line 4, page 29, lines 19-30 – enables individuals to collaborate over long distances, especially helpful for multinational corporations, page 3, lines 1-3); receiving the plurality of invention disclosures for each technology developer at a server system over a network and storing the plurality of invention disclosures for each technology developer as electronic documents in a database accessible to the server system (page 6, line 21 thru page 7, line 5, page 26, lines 20-28, Fig. 3);

storing, in the database, additional electronic documents associated with at least some of the plurality of invention disclosures for each technology developer (page 6, line 21 thru page 7, line 5, page 23, lines 10-23, Fig 7 (735), ;
maintaining and enforcing rights to electronic documents in the database such that at least some client systems associated with each technology developer in the plurality of technology developers can access selected ones of the electronic documents associated with invention disclosures created for the respective technology developer and such that client systems associated with a particular technology developer cannot access electronic documents in the database associated with invention disclosures of other unrelated technology developers in the plurality of technology developers (page 10, lines 4-26, page 28, lines 16-23, Fig. 3 (150) Security System, page 19, lines 21-31) ;
maintaining and enforcing rights to electronic documents in the database for client systems associated with a plurality of patent firms such that at least some client systems from selected ones of the patent firms have rights to view selected invention disclosures stored in the database and selected electronic documents stored in the database associated with the selected invention disclosures and create and modify patent applications prepared for the selected invention disclosures (page 10, lines 4-26, , page 28, lines 16-23, Fig. 3 (150);
receiving any such created patent application at the server system and storing it in the database (page 11, lines 18-26, page 22, line 28 thru page 23 line 4, page 23, lines 17-24);
maintaining and enforcing rights to file patent applications in a patent office for client systems associated with the plurality of law firms such that only selected client systems from the law firms have rights to file patent applications in the patent office (page 29 lines 5-18); and

electronically receiving a request from a client system to file a particular patent application for a first technology developer in the plurality of technology developers, determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request (page 29, lines 5-18).

Referring to Claim 4:

IBM further discloses the method of claim 19 wherein the plurality of different unrelated technology developers exchange documents with the server via the public Internet (page 7, lines 6-15).

Referring to Claim 5:

IBM further discloses the method of Claim 19 wherein the patent application is filed in the patent office with a correspondence mailing address set to an address associated with the server instead of an address associated with the first technology developer (col. 29, lines 5-18).

Referring to Claim 9:

IBM further discloses the method of claim 19 wherein documents and data associated with each invention disclosure are stored in the database and viewable over the Internet to client systems as determined by an access management portion of the server (page 10, lines 4-26, page 28, lines 16-23).

Referring to Claim 11:

IBM discloses the method of claim 19 wherein the patent application is filed in the patent office electronically in response to the request (page 29, lines 5 thru 18).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over IBM in view of Takano et al (US 6,434,580) (hereinafter referred to as Takano).

IBM discloses a server system for managing intellectual property, the system comprising:

a processor (page 11, lines 18-26 (112);

a database, coupled to the processor, for storing a plurality of electronic documents related to a plurality of invention disclosures for a plurality of different and unrelated technology developers, wherein the plurality of electronic documents include invention disclosures, patent applications and additional documents associated with the invention disclosures and/or patent applications

(page 11, lines 18-26 (112), page 20, lines 20-25, , page 23, lines 17-20, , page 26, lines 20-28);

an invention disclosure creation component that allows client systems from each of the plurality of technology developers to create invention disclosures for the respective technology developer each client system is associated with and store the invention disclosures in the database as

electronic documents page 15, line 31 thru page 23, line 8 (Idea Development, Figs. 2-3);

a document management and access component that maintains and enforces rights to electronic documents in the database such that (i) at least some client systems associated with each

technology developer in the plurality of technology developers can access selected ones of the electronic documents associated with invention disclosures created for the respective technology developer, (ü) client systems associated with a particularly technology developer cannot access electronic documents in the database associated with invention disclosures of other unrelated technology developers in the plurality of technology developers and (iii) at least some client systems from selected ones of the patent firms have rights to view selected invention disclosures stored in the database and selected electronic documents stored in the database associated with the selected invention disclosures and create and modify patent applications prepared for the selected invention disclosures (page 10, lines 4-26, Fig. 3 (150) Security System, page 28, lines 16-23);

a patent application filing component that, in response to receiving a request from a client system to file a particular patent application, determining if the client system has appropriate rights to file the particular patent application and, if so, causing the patent application to be filed in the patent office in response to the request (page 29, lines 5-18).

IBM does not disclose:

a patent application creation component that allows client systems associated with a plurality of patent firms to create and modify patent applications prepared for selected invention disclosures stored in the database and store the patent applications in the database as electronic documents;

However, Takano discloses:

a patent application creation component that allows client systems associated with a plurality of patent firms to create and modify patent applications prepared for selected

invention disclosures stored in the database and store the patent applications in the database as electronic documents (col. 6, lines 5-15, lines 19-22, Fig. 1 (202);

It would have been obvious to one of ordinary skill in the art to incorporate into the system of IBM the teachings of Takano since it allows for the preparation of a patent application while allowing for each the attorney-side computer and the client side computer to transmit to the other, and receive from the other, relevant data (Takano, col. 1, lines 59-67).

9. Claims 6, 7, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM as applied to claim 19 and 5 above, and further in view of Takano et (US 6,434,580) (hereinafter referred to as Takano).

Referring to Claim 6, 7 and 13:

IBM discloses the method of claim 5. IBM does not disclose a method further comprising, receiving from the patent office, paper correspondence related to the patent application that is mailed to the server system address, scanning the paper correspondence to create a scanned, electronic copy of the correspondence and storing the scanned, electronic copy of the correspondence in the database or that the scanned electronic copy of the correspondence is viewable over the Internet.

Takano discloses receiving from the patent office, paper correspondence related to the patent application that is mailed to the server system address (col. 15, lines 36-47, 50-54, Fig. 15 (500-502) Fig. 18).

It would have been obvious to incorporate into the method of IBM the teachings of Takano so as to provide notification that the patent information was actually received in the Patent Office.

Takano does not disclose a system or method in which the paper correspondence is scanned into the system and in which the scanned correspondence is viewable over the Internet. However, it would have been obvious to one of ordinary skill in the art to incorporate scanning into the system and method of Takano et al. because scanning saves time since documents do not have to be entered manually into a system. It has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192. It would be common sense that the method and system disclosed in Takano would allow for scanned documents to be viewed over the Internet since once the documents are entered into the system they would be able to be viewed as any other document in the system.

Referring to Claim 8:

IBM discloses the method of claim 19 wherein the method discloses a plurality of invention disclosures. IBM does not disclose a method wherein the plurality of invention disclosures are generated by responding to questions presented to client systems by the server via a Web page.

However, Takano discloses invention disclosures generated by responding to questions presented to client systems by the server via a Web page (col. 9, lines 46-51, Fig. 7, Fig. 2 (A1-Text preparation software actuated)).

It would have been obvious to incorporate into the method of IBM the teachings of Takano because this provides the benefit of making ready template data, which make up a specification form for the patent application and enable the inventor to easily prepare a specification for a patent invention (col. 9, lines 46-51).

Referring to Claim 13:

Neither IBM nor Takano disclose the method of claim 19 wherein the patent application is printed on a printer coupled to the server system and subsequently filed in the patent office by mail in response to the request.

However, it would have been obvious to one of ordinary skill in the art to print the application on a printer and file the patent office by mail since this is the old and well known way of filing patent applications prior to faxes and electronic filing and since filing patent applications by mail preceded electronic filings.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hunter et al. discloses a computer implemented expert support system for authorizing invention disclosures.

Eastman discloses a method and system for creating and storing shared documents in a common database with access levels.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jan Mooneyham whose telephone number is (703) 305-8554. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

[Signature]
*JAM**

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600